

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 64

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD H. TULLIS

Appeal No. 1998-0218
Application 08/078,768

MAILED

FEB 28 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before WILLIAM F. SMITH, ROBINSON, and ADAMS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

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REMAND TO THE EXAMINER

Oral argument was scheduled for this appeal on February 20, 2001. In a paper filed February 8, 2001, appellant has asked that the appeal be suspended in order to submit materials for consideration by the examiner. In the paragraph bridging pages 1-2 of the document, appellant states:

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In particular applicant wishes to inform the Patent Office of the issuance of U.S. Patent 5,919,619, issued from a continuation application to the present application filed May 31, 1995. In that patent prosecution, the Examiner and applicant reached agreement as to thirteen claims. Except for a single limitation, claim 1 of the 619 patent is identical [sic] to claim 1 now on appeal. Claim 1 of the 619 Patent is limited to methods of downregulated protein by antisense oligonucleotides in cell cultures, while the claims on appeal do not have the cell culture limitation. The Examiner's consideration of this issue will doubtless lead to simplification and possibly elimination of the issues before the board. This is because many of the objective bases for the extant § 112 rejection are applicable to uses of the invention under both in vivo and in vitro conditions. Consistency of examination requires reconsideration by the Examiner. A fuller discussion of the points and authorities appertaining to this issue will be submitted following remand.

In addition, appellant requests that a time period of 90 days be set for further submissions by applicant.

The issuance of the '619 patent is a circumstance which warrants remand of the application to the examiner to reconsider the issues pending in this appeal. According to appellant's representation, claim 1 of the '619 patent is identical to claim 1 on appeal but for a single limitation. It does not appear that the examiner has had the opportunity to review the patentability of the claims pending in this application in light of his decision to allow the '619 patent. It may be that the rejection pending in this application is inconsistent with the examiner's determination that the claims in the '619 patent are patentable. At the least, it would be appropriate for the examiner to set forth the facts and reasons why the claims pending in this application are considered to be non-

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enabled under 35 U.S.C. § 112, first paragraph, while the claims issued in the '619 patent were determined to be patentable. Furthermore, the issuance of the '619 patent may create double patenting issues.

Appellant requests that we "suspend" this appeal and set a 90 day period for submission of materials to the examiner. We decline to take either action. In our view, the more appropriate action is to vacate the hearing scheduled for February 20, 2001, and remand the application to the jurisdiction of the examiner to consider these issues.

Appellant was notified by way of telephone communication with Board personnel that the hearing scheduled for February 20, 2001, is vacated. See the confirmatory facsimile transmittal (Paper No 63).

We remand the application to the examiner to consider the effect the issuance of the '619 patent has on the issues pending in this appeal. The examiner should take whatever action is deemed appropriate. We decline to set a time period for appellant to submit further materials. We trust that upon return of the application to the jurisdiction of the examiner, the examiner and appellant can agree to a schedule in which subsequent proceedings can be conducted in an orderly manner.


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This application, by virtue of its "special" status, requires an immediate action.
Manual of Patent Examining Procedure § 708.01 (7th ed., rev. 1, February 2000). It is
important that the Board be informed promptly of any action affecting the appeal in this
case.

REMANDED


William F. Smith
Administrative Patent Judge


Douglas W. Robinson
Administrative Patent Judge


Donald E. Adams
Administrative Patent Judge

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